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10/613,920	07/02/2003	Frank Scozzari	051162-00001	4664

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C. Brandon Browning  
Sirote & Permutt, P.C.  
PO Box 55727  
Birmingham, AL 35255-5727

EXAMINER
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BASINGER, SHERMAN D

ART UNIT	PAPER NUMBER
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3617

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07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/613,920

Applicant(s)

SCOZZARI, FRANK

Examiner

Sherman D. Basinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehr et al in view of McConnell.

Lehr discloses for claim 3 a handle for a body board, comprising: a post 22 configured to pass through a body board and connect to an anchor 16; a strap 24 configured to attach to the post; a handle structure 14 configured to receive the strap, that strap 24 forms a loop and that the loop has an upper side received by the handle structure 14 and a lower side attached to the post 22 and forming an opening between the upper side and the lower side configured for receiving a hand-see figure 5.

Lehr does not disclose that the strap has a first end and a second end and that the handle 14 is configured to receive the first end of the strap. Lehr et al also does not disclose a buckle configured to receive the first end of the strap and the second end of the strap such that the strap forms a loop when the first end of the strap and the second end of the strap are attached to the buckle, and wherein the handle structure is configured to press a hand against the post when the strap is tightened through the buckle.

Note the strap 30 of McConnell which has a first end and a second end, and note the buckle 31 which receives the first end and the second end of the strap to form a loop and such that the strap is configured to press a hand against the part 9.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to provide a buckle similar to 31 of McConnell to strap 24 of Lehr et al and to provide first and second ends to the strap 24 of Lehr et al similar to the first and second ends of the strap of McConnell so that strap 24 of Lehr et al can be adjusted to press a hand against the post when the

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strap is tightened through the buckle. When strap 24 of Lehr et al is provided with a first end the handle 14 will inherently receive it.

Lehr et al also discloses the second post configured to pass through the body board and attach to an anchor.

With Lehr et al modified to have a buckle, the strap will form an elongated loop when the first end of the strap and the second end of the strap are attached to the buckle.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 13-15 have been considered but are moot in view of the new ground(s) of rejection.

Applicant has amended claim 13 to require the loop to include an upper side received by the handle structure and a lower side attached to the post and form an opening between the upper side and the lower side configured for receiving a hand. Support for the amendment is found in the application as originally filed at page 6, line 26 to page 7, line 5 and in the drawings at FIG. 5. No new matter has been added.

Claims 13-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lehr et al (U.S. Patent Application Publication No. 2002/0167136 A1) in view of McConnell (U.S. Patent No. 2,772,475). Applicant respectfully submits that the Examiner erred in rejecting claims 13-15 under 35 U.S.C. §103(a) by (1) using improper reference combinations which are not suggested by the prior art, and which nevertheless, (2) do not in combination teach or suggest the claimed invention. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

The question of obviousness under 35 U.S.C. § 103 is a question of law determined according to (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the art certain secondary considerations. See *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); *Richardson Vicks, Inc. v. Upjohn Co.*, 122 F.3d 1476, 1479, 44 USPQ2d 1181

(Fed. Cir. 1997). Upon review of an Examiner's rejection of an application under §103, the Board makes specific factual findings as to each of the Graham factors, when appropriate. See *Gechter v. Davidson*, 116 F.3d 1454, 1460 n.3, 43 USPQ2d 1030 (Fed. Cir. 1997) (dictum).

The scope and content of the prior art relevant to the invention is determined by (1) whether the art is from the same field of endeavor as the invention, and (2) if not, whether the art is reasonably pertinent to the particular problem with which the inventor

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is involved. See *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313 (Fed. Cir. 1986). The purposes of both the invention and the prior art are important in this determination. See *Clay*, 966 F.2d at 659.

If a reference properly falls within the scope of the applicable prior art, then the Examiner's proposed combinations or modifications of prior art must be motivated or suggested by the applied art, the nature of the problem to be solved or the general knowledge of persons of ordinary skill in the art at the time of the invention. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998). Therefore, that a proposed combination contains all of the elements of the claimed invention is by itself insufficient to support a finding of obviousness. See *id.* These principles are interrelated to the general rule that hindsight may not be used to establish obviousness. See *Kahn v. General Motors Corp.*, 135 F.3d 1472, 1479, 45 USPQ2d 1608 (Fed. Cir. 1998). In determining the differences between the prior art and the claimed invention, the Examiner must consider whether the invention as a whole would have been obvious at the time of the invention and not whether the differences themselves would have been obvious. See *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Each and every element of the claimed invention must be taught or suggested by the applied art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Specifically, the Examiner has erred in finding claims 13-15 unpatentable within the meaning of 35 U.S.C. §103(a) over *Lehr et al* and *McConnell* by using improper reference combinations which are not suggested in the applied arts. Accordingly, applicant submits that the applied references do not teach or suggest to one of ordinary skill in the art of stability and controlling devices for sport boards to combine the applied art in a manner that would render the claimed invention obvious. See *Rouffet*, 149 F.3d at 1355. The Examiner has not shown reasons why one of ordinary skill in the art, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the applied art for combination in the manner proposed. See *id.* at 1357; see also *Kahn*, 135 F.3d at 1480; *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957-58, 43 USPQ2d 1294 (Fed. Cir. 1997); *Lindemann Mach. GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481 (Fed. Cir. 1984) (nothing in the applied art alone or in combination taught or suggested the claimed invention as a solution to the problem the invention addressed). *Lehr et al* describe a handle 14 for a sports board 10 secured to the board using snap rivets 22 and a strap 24. Strap 24 is threaded through handle 14, and each snap rivet 22 is inserted through an aperture in an end of strap 24 and a snap post 34 of a runner 16 securing the strap to board 10.

The Examiner acknowledges that *Lehr et al* do not disclose the strap having a first end and a second end and that the handle is configured to receive the first end of the strap. The Examiner further acknowledges that *Lehr et al* do not disclose a buckle configured to receive the first end of the strap and the second end of the strap such that the strap forms a loop when the first end of the strap and the second end of the strap are attached to the buckle and wherein the handle structure is configured to press a hand against the post when the strap is tightened through the buckle. The Examiner

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thereafter states that it would be obvious to provide a buckle similar to 31 of McConnell to strap 24 of Lehr et al and to provide first and second ends to the strap 24 of Lehr et al similar to the first and second ends to the strap of McConnell so that strap 24 of Lehr et al can be adjusted to press a hand against the post when the strap is tightened through the buckle.

Applicant respectfully submits that, contrary to the assertion of the Examiner, it would not be obvious to modify the sports board handle and strap of Lehr et al by providing a buckle to the strap and first and second ends to the strap, as described by McConnell, so that the strap can be adjusted to press a hand against the post when the strap is tightened through the buckle. More particularly, McConnell describes a grape vine and twine cutting knife including a transversely bowed handle part 8 having an upper surface constituting a hand engaging part 9 and upstanding strap engaging portions adjacent to the ends of the handle. A strap member 30 having a buckle 31 adjustably attached at one end thereof is passed through an opening 12 in the forward strap engaging portion and folded back on itself with the other end of the strap being fed through the rearward strap engaging portion and attached to the buckle providing a two ply strap. In use, the middle finger, ring finger and little finger are inserted between the handle surface 9 and the two plies of strap 30.

McConnell is from a completely different field of endeavor as the present invention and the sports board handles described by Lehr et al, and is not reasonably pertinent to the particular problem with which the applicant is involved, i.e., to provide a stability and controlling device for a sports board. Thus, McCormell in view of Lehr et al does not suggest providing a sports board handle and strap having a buckle and first and second ends to the strap so that the strap can be adjusted to press a hand against the post when the strap is tightened through the buckle. Furthermore, McCormell teaches away from such a combination since McConnell teaches a convex handle part against which a user's hand is pressed. Having a handle, rather than flat base as shown in applicant's claimed invention, would decrease stability. In addition, rather than having a pliable loop that wraps around a user's hand and adjusts to fit snugly there around as described by applicant, McCormell teaches forming an opening between two plies of strap and a rigid handle part surface and then cinching three fingers against the handle part surface by adjusting the two ply strap. Again, McConnell teaches a feature that decreases rather than increases stabilization and control. Thus, the skilled artisan would not have relied upon the teachings of McConnell to reach the claimed invention or to solve the problems addressed by the applicant in conceiving and reducing to practice the claimed invention. Further, while Lehr et al may describe a body board or sports board handle, neither Lehr et al nor McConnell suggests that any of the respective features of one of the described handles should or can be combined with the features of the other handle. For example, Lehr et al nor McConnell makes any mention of providing a buckle similar to the buckle of McConnell to the strap of Lehr et al or providing the first and second ends to the strap of Lehr et al to the first and second ends to the strap of McConnell so that the strap of

Lehr et al can be adjusted to press a hand against the post when the strap is tightened through the buckle. The "mere fact that the prior art could be so modified would not

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have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon et al, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Thus, in absence of any such suggestion, a prim-facie case of obviousness has not been shown.

In rebuttal, first McConnell is analogous art because what we are looking at here is a strap with a buckle than can be used to adjust the strap. Any device with such a strap would be analogous art. McConnell discloses such a strap and therefore is analogous art.

Second, while applicant may have disclosed different functions of his invention in his specification, what is being examined are the claims. The claims must differ from the prior art by structure, not by intended use or function disclosed in the specification. The claimed structure is made obvious by Lehr and McConnell. To provide a buckle to adjust a strap is very well know. For example, a belt worn with clothing. McConnell discloses a strap used to form a loop configured to receive a hand and the strap of McConnell has a buckle. This suggest providing a buckle to another strap configured to receive a hand. This would be the strap of Lehr et al.

Applicant continues his arguments by stating, even assuming a suggestion to combine the references exists, the references fail to teach or suggest each and every feature of the claimed in invention. In particular, the claimed invention is directed to body board handle including a post configured to pass through the body board and connect to an anchor, a strap configured to attach to the post, the strap having a first end and a second end, a handle structure configured to receive the first end of the strap, and a buckle configured to receive the first end of the strap and the second end of the strap such that the strap forms a loop when the first end of the strap and the second end of the strap are attached to the buckle. It is a further feature of the claimed invention that the loop includes an upper side received by the handle structure and a lower side attached to the post and forming an opening between the upper side and the lower side configured for receiving a hand wherein the handle structure is configured to press the hand against the post when the strap is tightened through the buckle.

Lehr et al and McConnell, alone or in combination, fail to teach the claimed loop having an upper side received by the handle structure and a lower side attached to the post and forming an opening between the upper side and the lower side configured for receiving a hand. Rather, Lehr et al. describes a strap connected at each end to a board, while McConnell describes a two-ply strap connected at each end to a handle part. In each instance, no loop

is formed by a strap and configured to receive a hand. Because the references fail to teach this feature, a prime facie case of obviousness has not been shown. Accordingly, withdrawal of the rejection is respectfully requested.

In rebuttal Lehr et al teaches the limitation of the loop having an upper side received by the handle structure and a lower side attached to the post and forming an opening between the upper side and the lower side configured for receiving a hand. In figure 5 of Lehr et al the upper side of the loop is received by the handle 14. The lower side of the loop is attached to either post 24. The part of the loop 24 of Lehr et al which forms the lower side of the loop is the part through which either of the posts 22 pass.

Thus, claim 13 does not add any structure not disclosed by Lehr et al as combined by McConnell. The area between either of the post 22, the strap portion through which the post passes and the upper portion of the strap 24 which passes through the handle 14 forms an opening configured for receiving a hand.

For the above reasons, the rejections stand.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 571-272-6679. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sherman Basinger/  
Sherman Basinger, PE  
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Friday, June 29, 2007

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